

## REMARKS

This Response Under 37 CFR 1.111 is presented in response to the Office Action mailed from the US Patent Office on September 10, 2007. Claims 1, 16, 21, 25 and 32, the independent claims are amended hereby. Claims 1, 4-6, 9, 14-16, 19-21, 23 and 25-33 remain pending hereinafter. Claims 7, 8, 10-13 are previously withdrawn, and claims 2, 3, 17, 18, 22 and 22 are previously cancelled. Reconsideration of this application in view of the amendments to the independent claims and the below remarks is respectfully requested.

In the outstanding Office Action: **I.)** Claims 1, 5-6, 16 and 19-20 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,270,810 to **Nishimura** in view of U.S. Patent No. 4,755,873 Kobayashi and further in view of U.S. Patent No. 6,968,119 issued to Kaku. **II.)** Claim 4 is rejected under § 103(a) as obvious over **Nishimura**, Kobayashi and Kaku, and still further in view of US Patent No. 6,059,718 to Taniguchi et al. (Taniguchi). **III.)** Claim 9 is rejected under § 103(a) as obvious over **Nishimura**, Kobayashi and Kaku, and still further in view of US Patent No 5,825,982 to Wright, et al. (Wright). **IV.)** Claim 14 is rejected under § 103(a) as obvious over **Nishimura**, Kobayashi and Kaku, and still further in view of US Patent No. 5,260,765 to Sakai, et al. (Sakai). **V.)** Claim 15 is rejected under § 103(a) as obvious over **Nishimura**, Kobayashi and Kaku, and still further in view of US Patent No. 6,243,531 to Takeuchi, et al. (Takeuchi). **VI.)** Claims 21, 23 are rejected under § 103(a) as obvious over Kobayashi and **Nishimura**, and still further in view of Kaku. **VII.)** Claims 25, 27, 28 and 32-34 are rejected under § 103(a) as obvious over **Nishimura** and Kaku. **VIII.)** Claim 26 is rejected under § 103(a) as obvious over **Nishimura**, Kaku and Taniguchi. **IX.)** Claim 29 is rejected under § 103(a) as obvious over **Nishimura**, Kaku and Wright. **X.)** Claim 30 is rejected under §

103(a) as obvious over **Nishimura**, Kaku and Sakai. **XI.)** Claim 31 is rejected under § 103(a) as obvious over **Nishimura**, Kaku and Takeuchi.

I.) Response to Rejection of claims 1, 5-6, 16 and 19-20 under § 103(a)

At paragraph 6 of the outstanding OA, the Examiner states that Nishimura discloses an image recording apparatus, comprising a connector through which a motion image is inputted (Fig. 1), a memory which an image of the motion image inputted through the connector, which constructs one frame, is stored as a still image (still image memory 34, Fig. 1) and a display device on which the image (motion image) is displayed.

Nishimura's processor 20 receives a motion image from endoscope 1 at video signal processor circuit 21, which processes the signal to put it in better physical form for conversion in A/D converter 22. Once digitized, RGB field picture signals representative of the digitized motion image signal are stored in RGB memories 23R, 23G, 23B. Using switch 36R, 36G, 36B, the field picture signals in memories 23R, 23G, 23B are switched through RGB noise reducers 27R, 27G, 27B, and converted to analog via RGB designated D/A converters 24R, 24G, 24B, and output to the display device. Real time RGB signals renew the memory stored field picture signals in RGB memories 23R, 23G, 23B with each incoming frame of new image data. The instant stored RGB frame is mixed with a previously stored frame, using coefficients  $k$  and  $1-k$  based on detected motion in the instant frame as compared to said previously stored frame. The converted analog out is the video signal displayed.

In addition to memories 23R, 23G, 23B, Nishimura includes a still image memory circuit 34R, 34G, 34B, which is also connected to A/D converter 22, and records in a manner parallel to recording of field images by motion image (field) memories 23R, 23G, 23B, and is controlled by

operation section. Nishimura's operation section comprises Nishimura's still image control circuit 35, which requires as operation section inputs a signal from RGB control sensor 25, a signal from motion detector 32 and a freeze signal from freeze input signal terminal 37.

Nishimura's operation section (still image control circuit) 35 is supplied with a motion signal from noise detection means 32R, 32G, 32B (comprising noise reducers 27R, 27G, 27B), an R, G, B enabling signal from sensor 25 (to operate either R, G or B circuits) and the freeze signal. Only when the detected motion signal is small, the freeze signal (enable) and the proper RGB enable signal are present as inputs to the operation section (35) an incoming field signal (motion image) be stored in respective ones of R, G or B still image memories 34R, 34G, 34B (that is, depending on the R, or G, or B enabling signal from sensor 25).

The Examiner further asserts that Nishimura discloses an image signal switching circuit (switch 36R, 36G, 36B) for switching between 1.) a motion image input through the "connector" and stored in motion (field) image memories 23R, 23G, 23B, and 2.) the still image read from still image memories 36R, 36G, 36B, and outputting a selected one of the stored motion or still images to the display device (switch means 36, Fig. 1, col. 4, lines 1-5, col. 5, lines 9-28).

Applicants disagree that Nishimura switches a motion image inputted through the connector because Nishimura does not teach outputting the motion image provided by CCD 6. Nishimura can display only 1.) a motion image input through the "connector" and stored in motion (field) image memories 23R, 23G, 23B, or 2.) the still image read from still image memories 36R, 36G, 36B, but only after either of the memory-stored signals are processed by respective R, G, B noise reducers 27R, 27G, 27B. Image signal switching circuit 36R, 36G, 36B does switch between the memory-stored motion image signal (stored in motion image memories 23R, 23G, 23B) and memory-stored still image signal (stored in still image memories 34R, 34G,

34B) by use of operation section (still control) 35. That is, operation section (still control) 35 drives Nishimura's switch means 36R, 36G, 36B, in response to a freeze signal from freeze signal input terminal 37, motion detector 32 of noise reducers 27R, 27G, 27B, and RGB motion sensor 25, as described above.

When a motion signal from motion sensor 32 indicates sufficient lack of movement in an incoming frame, AND in the presence of the proper R, G, or B enabling signals from sensor 25, the motion image signal (from A/D converter 22) is stored as a still image in motion image memories 23R, 23G and 23B, and displayed (output through switch means 36R, 36G or 36B, and Noise reducers 27B, 27G, 27B, and D/As 24R, 24G, 24B. When this same operation is further actuated by the freeze control signal, the motion image is stored in still image memories 34R, 34G, 34B, as it is contemporaneously displayed.

Hence, Nishimura's operation section (35), by the freeze signal at freeze signal input terminal 37, the motion signal from motion detector 32, and RGB synchronization signal from sensor 25, controls whether a motion image is stored as a motion image in still image memories 34R, 34G, 34B, and switching for display between the stored motion image and the stored still image. While motion is arbitrary, the user controls which memory-stored signal is presented by the display device by pressing an actuator at the freeze signal input terminal (37). The user does not have input for deciding what is recorded using Nishimura. Any time the operation section (35) allows an incoming motion image to be stored as a still image in still image memories 34R, 34G, 34B, same stored still image is recorded.

With Nishimura, a user does not have an option to record either a still or motion image. For that matter, in Nishimura, the user does not have an option to NOT to record a still image

signal when a still image signal is stored. Nishimura's construction, and its operating section (35) determine same.

The Examiner further asserts that Nishimura includes a recording control circuit for, when the operation section (still control 35) instructs to switch an image to be displayed, if an image displayed on the display device is switched to still image by the image signal switching circuit, setting the recording mode to a still image recording mode [ ...]. The Examiner, in an effort to establish a prima facie case of obviousness, asserts that the recording control circuit only can carry out part of what applicants' claimed recording control circuit is required to carry out, and does not suggest that Nishimura's operation section (35) is capable of driving the part of applicants' recording control section assertedly found in Nishimura.

Applicants have amended independent claims 1, 16, 25 and 32 to more clearly distinguish the recording control circuit claimed therein from the prior art references. As amended, the recording control circuit, in response to the operation section instructing to switch an image to be displayed on the display device, determines whether the image displayed on the display device is switched to a still image by the image signal switching circuit, then setting the image recording mode to the still image recording mode interlockingly with display of the still image, and if an image displayed is switched to a motion image, then setting the image recording mode to a motion image recording mode interlockingly with display of the motion image. Similarly, independent method claim 21 is amended.

The language of claim 21 now makes clear that the recording mode setting step, in response to the operation section instructing to switch an image to be displayed on the display device, determines whether the image displayed is to switched to the still image by the image signal switching circuit, and if so sets the image recording mode to the still image recording

mode interlockingly with display of the still image, where if the image displayed is to be switched to a motion image, setting the image recording mode to a motion image recording mode interlockingly with display of the motion image.

Applicants respectfully assert that Nishimura does not record motion images, but records only still images contemporaneously with storing a field image to still image memory by the freeze signal (input at freeze signal input terminal 37), but does not include a “still image record mode” circuit, or “still image record mode” signal means for generating a signal to drive a particular recording mode interlockingly with display of the of the still image. Nishimura only records still images, and this is done automatically. A still image recording mode only makes sense, and would be included only if there was a motion image recording mode. Then, there would be a two-step record process, with a still image recording mode, and a motion image recording mode, as in applicants’ invention as claimed. Because Nishimura includes means that automatically record when a still image is stored, there are no “modes,” or means for generating mode signals.

MPEP 2141 provides examination guidelines for determining obviousness under 35 USC 103 based on KSR International Co. v. Teleflex, Inc. (KSR), 82 USPQ2d 1385 (US Sup. Ct. 2007). MPEP 2141(I) states that in an obviousness determination, the operative question is whether the improvement is more than the predictable use of the prior art elements according to their established functions. Id. at 1396. Because the Examiner’s obviousness determination includes that Nishimura discloses only part of the claimed recording control circuit, and because same part of applicants’ claimed recording control circuit must operate with applicants’ claimed operation section, Nishimura’ recording control circuit can not be equivalent to applicants’

claimed recording control circuit, and Nishimura's operation section (35) can not operate as applicants' claimed operation section to drive the recording control circuit.

For that matter, applicants respectfully assert that the elements of applicants' claimed invention in combination do not merely perform the function that each element performs separately, and that it is the claimed subject matter as a whole that is what is most important to this, and any obviousness determination.

The Examiner further asserts that Nishimura includes a recording processing circuit for, when the operation section (35) instructs image recording, if an image displayed on the display device is switched to the still image by the image signal switching circuit (36R, 36G, 36B), recording the still image in the still image recording mode onto a predetermined recording medium (38) [ ... ]. As discussed with respect to the recording control circuit, applicants' "whole" or completely operational recording processing circuit is not found in Nishimura, and the Examiner does not suggest that Nishimura's operation section (35) can be used to operate the portion of applicants' recording processing circuit found in Nishimura. For that matter, the proposed modification of Nishimura would change Nishimura's inherent principles of operation, otherwise the Examiner would not acknowledge that Nishimura's operation section (35) is incompatible with applicants' claimed operation section. In re Ratti, 123 USPQ 349 (CCPA 1959).

At page 8 of the outstanding OA, the Examiner further states that Nishimura fails to specifically disclose 1) an operation section for instructing the image signal switching circuit to switch an image to be displayed on the display device, and 2) for instructing start of image recording, Kobayashi does by combination of its freeze switch 47, release switch 48 and VTR switch 49.

Applicants respectfully disagree. As already stated, Nishimura includes both an operation section (still control 35, Fig. 2), which is responsive to signals from motion detector 32, sensor 25 and freeze signal input terminal 37 ("Kobayashi's operation section"), and same operation section also controls start of image recording. Nishimura automatically records when its operation section (35) allows it to capture, or memory store an incoming frame. There is no need to use Kobayashi operation section in lieu of Nishimura's without inherently acknowledging that neither Nishimura, nor Kobayashi, can supply the stated claimed elements without substantial modification. If substantial modification is required, it negates that one skilled in the art would obviously know to make the combination, and modifications, to realize the claimed elements. This runs contrary to what is stated in MPEP 2141.

The Examiner further states that Kobayashi teaches an endoscope including a video camera 46, that is provided with remote control switches (operation section) including freeze switch 47, release switch 48 and VTR switch 49, equating same to applicants' claimed operation section. Applicants respectfully disagree that their claimed operation section is found in Kobayashi's switch 47, release switch 48 and VTR switch 49 (Kobayashi's operation section), because same elements are not constructed to instruct applicants' claimed recording control circuit, and recording processing circuits. For that matter, the asserted Kobayashi operation section does not include a signal means or sensor such as R, G, B, sensor 25 of Nishimura, which is required to instruct Nishimura to memory store and record still images.

If Kobayashi does not include a means to control Nishimura's R, G, and B operation, including RGB operation of switches 36R, 36G, 35B, it follows that one skilled in the art would not find it obvious to combine Kobayashi with Nishimura to provide Nishimura a control section as claimed. That is, 1) Kobayashi's operation section is not equivalent to applicants' claimed



operation section, and 2) Kobayashi's operation section is not constructed to properly drive Nishimura's operation section.

The Examiner continues, and notes that the proposed 103(a) combination of Nishimura and Kobayashi fail to disclose a recording control circuit as claimed, for if an image displayed on the display device is switched to the motion image by the image signal switching circuit, setting the image recording mode to motion image recording mode, and a recording processing circuit, for if an image displayed is switched to motion image by the image signal switching circuit, recording the motion image in the motion image recording mode onto the predetermined recording medium. The Examiner then states that Kaku teaches an electronic camera that records motion and still images (col. 4, lines 25-65), and it would have been obvious to combine Kaku's camera with Nishimura and Kobayashi.

Applicants respectfully disagree that Kaku's electronic camera recording processing circuit is equivalent to applicants' claimed recording processing circuit (particularly as amended hereby), or that it can be combined with Nishimura and Kobayashi to modify same to realize an endoscope device, which records both still and motion images, as set forth in applicants' independent claim language. At col. 4, lines 25-45, Kaku describes operating a monitoring mode, where no compression or write commands are issued from the system controller 13 so that image compression circuit 10 and write control circuit 11 will not operate in monitor mode, such that motion images are merely displayed on the monitor without being recorded onto memory card 12. Nowhere in the cited Kaku text at col. 4, lines 25-45, does Kaku mention setting an image recording mode to a motion image recording mode interlockingly with display of the motion image, nor does the cited text support the work of a recording processing circuit for if an

image displayed on the display device is switched to motion image by the image switching circuit, recording the motion image in the image recording mode.

Applicants further state, however, that even if Kaku did include elements equivalent to applicants' claimed recording control circuit and record processing circuit, for arguments sake, the Kaku construction could not be used to interface and control the proposed combination of Nishimura and Kobayashi, as described in detail above, without significant modification. Hence, modifying Kaku to operate in such a way as to control applicants' claimed recording control circuit, and recording processing circuit would change the principles of operation of Kaku, in violation of the principles set forth in In re Ratti. The modifications required are such that one skilled in the art would not obviously think to use or combine Kaku with the proposed combination of Nishimura and Kobayashi.

Hence, the teachings of Nishimura, Kobayashi and Kaku, taken alone or in any proper combination, fails to disclose or suggest "...a recording control circuit for, when the operation section instructs to switch an image to be displayed on the display device, if an image displayed on the display device is switched to the still image by the image signal switching circuit, setting the image recording mode to the still image recording mode interlockingly with display of the still image, and if an image displayed on the display device is switched to the motion image by the image signal switching circuit, setting the image recording mode to the motion image recording mode interlockingly with the display of the motion image; and, a recording processing circuit for, when the operation section instructs image recording, if an image displayed on the display device is switched to the still image by the image signal switching circuit, recording the still image in the still image recording mode onto a predetermined recording medium, and if an image displayed on the display device is switched to the motion image by the image signal

switching circuit, recording the motion image in the motion image recording mode onto the predetermined recording medium” as recited in claim 1.

Independent claims 16 recites similar language claiming the same subject matter, and is patentable with claim 1 in view of Nishimura, Kobayashi and Kaku for at least the same reasons. Therefore, claims 5, 6, that depend from claim 1 and claims 19 and 20 that depend from claim 16 are patentable for at least the same reasons.

## II.) Response to Rejection of claim 4 under § 103(a)

Claim 4 was rejected under 35 U.S.C. § 103(a) as obvious over Nishimura, Kobayashi, Kaku, and further in view of U.S. Patent No. 6,059,718, issued to Taniguchi et al. Applicants respectfully assert, however, that claim 4 depends from independent claim 1, and includes all the limitations of independent claim 1. Taniguchi, et al., fail to overcome the deficiencies cited above with regards to Nishimura, Kobayashi and Kaku, with respect to independent claim 1. Consequently, Nishimura, Kobayashi, Kaku, taken alone or in any proper combination with Taniguchi, fail to disclose or suggest Applicants’ invention of claim 1 qualified to include the feature recited by claim 4. Specifically, the cited prior art references fail to disclose or suggest that the recording control circuit includes an information memory in which information indicating whether an image outputted to the display device via the image signal switching circuit is a still image or a motion image is stored; and the recording control circuit automatically determines a recording mode of recording processing by the recording processing circuit by referring to the information stored in the information memory indicating whether a still image or a motion image when the operation section instructs image recording.

Therefore, and for at least the reasons provided above for the patentability of independent claim 1, claim 4 is allowable over the cited prior art references, and applicants respectfully request withdrawal of the rejection with respect to claim 4 under 35 U.S.C. § 103(a) over the combination of Nishimura, Kobayashi, Kaku and Takeuchi et al.

### III.) Response to Rejection of claim 9 under § 103(a)

Claim 9 was rejected under 35 U.S.C. § 103(a) as obvious over Nishimura, Kobayashi, Kaku, and further in view of U.S. Patent No. 5,825,982 issued to Wright, et al. Applicants respectfully assert, however, that claim 9 depends from independent claim 1, and includes all the limitations of independent claim 1. Wright, et al., fail to overcome the deficiencies cited above with regards to Nishimura, Kobayashi and Kaku, with respect to independent claim 1. Consequently, Nishimura, Kobayashi, Kaku, taken alone or in any proper combination with Wright, et al., fail to disclose or suggest Applicants' invention of independent claim 1, further limited by the feature recited by claim 9. Specifically, the cited prior art references fail to disclose or suggest a graphic processor for producing graphic image data in response to an instruction from the recording control circuit, wherein the image signal switching circuit outputs graphic image data generated in the graphic processor to the display device.

Therefore, and for at least the reasons provided above for the patentability of independent claim 1, claim 9 is allowable over the cited prior art references, and applicants respectfully request withdrawal of the rejection with respect to claim 9 under 35 U.S.C. § 103(a) over the combination of Nishimura, Kobayashi, Kaku and Wright, et al.

IV.) Response to Rejection of claim 14 under § 103(a)

Claim 14 was rejected under 35 U.S.C. § 103(a) as obvious over Nishimura, Kobayashi, Kaku, and further in view of U.S. Patent No. 5,260,795 issued to Sakai, et al. Applicants respectfully assert, however, that as claim 14 depends from independent claim 1, it includes all the limitations recited therein. Sakai, et al., fail to overcome the deficiencies cited above with regards to Nishimura, Kobayashi and Kaku. Consequently, Nishimura, Kobayashi, Kaku, taken alone or in any proper combination with Sakai, fail to disclose or suggest Applicants' invention as recited in independent claim 1, further limited by the feature of claim 14. Specifically, the cited prior art references fail to disclose or suggest a voice recording processing circuit that records a voice signal.

Therefore, and for at least the reasons provided above for the patentability of independent claim 1, claim 14 is allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to claim 14 under 35 U.S.C. § 103(a) over the combination of Nishimura, Kobayashi, Kaku and Sakai, et al.

V.) Response to Rejection of claim 15 under § 103(a)

35. Claim 15 was rejected under 35 U.S.C. § 103(a) as obvious over Nishimura, Kobayashi, Kaku, and further in view of U.S. Patent No. 6,243,531 to Takeuchi, et al. Applicants respectfully assert, however, that as claim 15 depends from independent claim 1, it includes all the limitations recited therein. Takeuchi, et al., fail to overcome the deficiencies cited above with regards to Nishimura, Kobayashi and Kaku, with respect to independent claim 1. Consequently, Nishimura, Kobayashi, Kaku, taken alone or in any proper combination with Takeuchi, fail to disclose or suggest Applicants' invention as recited in independent claim 1, and the feature of claim 15. Specifically, the cited prior art references fail to disclose or suggest wherein the remaining storage capacity of the recording medium, which is available for storage of information, is detected to be indicated.

Therefore, and for at least the reasons provided above for the patentability of independent claim 1, claim 15 is believed allowable over the cited prior art references, and applicants respectfully request withdrawal of the rejection with respect to claim 15 under 35 U.S.C. § 103(a) over the combination of Nishimura, Kobayashi, Kaku and Takeuchi, et al.

VI.) Response to Rejection of Claims 21 and 23 under § 103(a)

Claims 21 and 23 were rejected under 35 U.S.C. § 103(a) as obvious over Kobayashi in view of Nishimura, and further in view of Kaku. The Examiner asserts that Kobayashi discloses an image recording method in an image recording apparatus that is constructed with means for selecting and operating to record one of a motion image and a still image using an image selecting circuit to output the selected image to a display device. Applicants respectfully disagree that Kobayashi's means for operating and selecting to record allow it to both observe both motion and still images, and record both motion and still images. Kobayashi does not include means for recording motion images, nor means for switching from still observation mode to motion observation mode and recording the motion image observed in motion observation mode.

The Examiner then asserts that Kobayashi includes a recording starting step of instructing start of image recording by VTR switch 29, and inherently by exclusion that Kobayashi fails to teach a displayed image judging step for judging whether an image selected by the image selecting circuit and displayed on the display device is the still image or the motion image. The Examiner continues by asserting that Kobayashi includes a recording mode setting step for setting the image recording mode to a still image recording mode.

Applicants respectfully disagree. As discussed above with respect to the section 103(a) rejections of independent claim 1, Kobayashi does include means for setting one of multiple recording modes because Kobayashi only records still images. Hence, while applicants' inventive method includes a recording mode step for setting the still image recording mode to a still image recording mode (interlockingly with display of the still image), this is inaccurate.

Kobayashi just records still images when the freeze switch is actuated, and has no need for a recording mode setting step, or its equivalent. The Examiner further asserts that Kobayashi includes a recording processing step of recording an image displayed on the display device onto a recording medium according to the result of setting at the recording mode setting step (col. 5, lines 30-49). As already mentioned, since Kobayashi automatically captures and records a frozen or still image, Kobayashi does not respond to a recording mode setting step as required by claim 21.

The Examiner further asserts that Kobayashi fails to disclose a displayed image judging step for judging whether an image selected by the image selecting circuit and displayed on the display device is the still image or the motion image, that Nishimura's freeze a signal via freeze signal input terminal 37, together with still image memory store circuit 35 (which with sensor 25 comprise Nishimura's operation section) judges if what is displayed is a motion or still image. As stated above, Nishimura switches between observing a motion image or a still image by use of a freeze signal provided at the freeze signal input terminal 37. If the freeze signal is not present to operate in still mode, Nishimura displays the motion image. When actuated to observe a still image, the still image, if observable at all by the motion sensor, also records the still image contemporaneously. Switching from motion imaging viewing to still image viewing and recording is not based on any logical events but for the presence of a freeze signal and signal from the motion detector, the freeze signal an active user input.

Because Nishimura could not execute a displayed image judging step for judging whether an image selected by the image selecting circuit and displayed on the display device is the still image or the motion image, it could not be combined with Kobayashi in order to obtain an



endoscope device which has the ability to recognize the display mode such as motion picture mode or still picture mode. That is, even if the Kobayashi and Nishimura could be properly combined, the proposed combination would not recognize the display mode such as motion picture mode or still picture mode.

The Examiner further asserts that Kobayashi and Nishimura together fail to disclose whether the displayed image judging step judges that the image displayed on the display device is the motion image, setting the image recording mode to a motion image recording mode, but that Kaku teaches an electronic camera that records both motion and still images, and that it would have been obvious to modify the Kobayashi and Nishimura combination by the Kaku camera teaching (Fig. 1 is Kaku's camera) to obtain an endoscope device that records both motion and still images.

Applicants respectfully disagree. Kobayashi already has a camera 46 and camera and camera 33d and monitor 33c, combination. Such a combination would not be proper, therefore the skilled artisan would not think to make such a combination. That is, such an improper combination could not realize applicant's claimed step of setting a recording mode to a motion image recording mode (interlockingly with the display of the motion image after the step of judging judges that the display is displaying a motion image.

Applicants respectfully assert, therefore, that Kobayashi, Nishimura and Kaku, whether alone or in combination, do not render applicants' independent claim 21 obvious under section 103(a). Specifically, the cited prior art references fail to disclose or suggest the method of independent claim 21. Claim 23 depends from claim 21 and is patentable therewith. Applicants, therefore, respectfully request withdrawal of the rejection of claims 21 and 23 under 35 U.S.C. § 103(a) over the combination of Kobayashi, Nishimura and Kaku.

VII.) Response to Rejection of Claims 25, 27, 28 and 32-34 under § 103(a)

Claims 25, 27, 28 and 32-34 were rejected under 35 U.S.C. § 103(a) as obvious over Nishimura in view of Kaku. The Examiner asserts that Kobayashi discloses a connector, memory, display device, image signal switching circuit, recording control circuit and recording processing circuit (both as modified by the Examiner and asserted above with respect to the rejection of claim 1 in view of Nishimura under section 103(a)). The Examiner further asserts that Nishimura fails to disclose a recording control circuit, for if an image displayed on the display device is switched to a motion image by the image signal switching circuit, setting the image recording mode to motion image recording mode (interlockingly with display of the motion image), and a recording processing circuit, for if an image displayed on the display device is switched to the motion image by the image signal switching circuit, recording the motion image in the still image recording mode onto the predetermined recording medium, but that Kaku discloses an electronic camera (Fig 1) and that it would have been obvious to modify Nishimura by Kaku to record both still and motion images.

Applicants respectfully disagree that Nishimura includes each of applicant's elements as asserted. But for arguments sake assuming that Nishimura does include: a recording control circuit for, if an image displayed on the display device is switched to the still image by the image signal switching circuit, setting the image recording mode to still image recording mode interlockingly with display of the still image, and a recording processing circuit for if an image displayed on the display device is switched to the still image by the image signal switching circuit, recording the still image in the still image recording mode onto the predetermined

recording medium, and assuming that Kaku's electronic camera (Fig 1) includes same limitations, and assuming that it would have been obvious to the skilled artisan to combine Kaku with Nishimura, the combined references would still not realize applicants' invention as set forth in claim 25.

The Examiner's argument with respect to claim 32, that it would have been obvious to modify Nishimura by Kaku, is quite similar to the rejection of claim 25 under section 103(a) over Nishimura and Kaku. Applicants, therefore, respectfully assert that claim 32 is patentable under section 103(a) in view of Nishimura and Kaku for at least the reasons set forth for the patentability of claim 25. Claims 27 and 28 depend from claim 25 and are patentable therewith; likewise, claims 33 and 34 depend from claim 32 and are patentable therewith. Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 25, 27, 28 and 32-34 under section 103(a) over Nishimura and Kaku.

#### VIII.) Response to Rejection of claim 26 under § 103(a)

Claim 26 was rejected under 35 U.S.C. § 103(a) as obvious over Nishimura, Kaku and Taniguchi. Applicants respectfully assert, however, that as claim 26 depends from independent claim 25, it includes all the limitations recited therein. Taniguchi, et al., fail to overcome the deficiencies cited above with regards to Nishimura and Kaku. Consequently, Nishimura and Kaku, taken alone or in any proper combination with Taniguchi, fail to disclose or suggest applicants' invention as recited in independent claim 25, and the feature of claim 26.

Specifically, the cited prior art references fail to disclose or suggest wherein: the recording control circuit includes an information memory in which information indicating whether an

image outputted to the display device via the image signal switching circuit is a still image or a motion image is stored; and the recording control circuit, when recording an image, automatically determines a recording mode of recording processing by the recording processing circuit by referring to information stored in the information memory indicating whether said image is a still image or a motion image.

Therefore, and for at least the reasons provided above for the patentability of independent claim 25, claim 26 is allowable over the cited prior art references, and applicants respectfully request withdrawal of the rejection with respect to claim 26 under 35 U.S.C. § 103(a) over the combination of Nishimura, Kaku and Taniguchi.

IX.) Response to Rejection of claim 29 under § 103(a)

Claim 29 was rejected under 35 U.S.C. § 103(a) as obvious over Nishimura, Kaku and Wright. Applicants respectfully assert, however, that as claim 29 depends from independent claim 25, it includes all the limitations recited therein. Wright fails to overcome the deficiencies cited above with respect to Nishimura and Kaku, in the context of the patentability of independent claim 25. Consequently, Nishimura and Kaku, taken alone or in any proper combination with Wright, fail to disclose or suggest Applicants' invention as recited in independent claim 25, and the feature of claim 29. Specifically, the cited prior art references fail to disclose or suggest a graphic processor for producing graphic image data in response to an instruction from the recording control circuit, wherein the image signal switching circuit outputs graphic image data generated in the graphic processor to the display device.

Therefore, and for at least the reasons provided above for the patentability of independent claim 25, claim 29 is allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to claim 29 under 35 U.S.C. § 103(a) over the combination of Nishimura, Kaku and Wright.

X.) Response to Rejection of claim 30 under § 103(a)

Claim 30 was rejected under 35 U.S.C. § 103(a) as obvious over Nishimura, Kaku and Sakai. Applicants respectfully assert, however, that as claim 30 depends from independent claim 25, it includes all the limitations recited therein. Sakai fails to overcome the deficiencies cited above with regards to Nishimura and Kaku in the context of the patentability of independent claim 25. Consequently, Nishimura and Kaku, taken alone or in any proper combination with Sakai, fail to disclose or suggest Applicants' invention as recited in independent claim 25, and the feature of claim 30. Specifically, the cited prior art references fail to disclose or suggest a voice recording processing circuit that records a voice signal.

Therefore, and for at least the reasons provided above for the patentability of independent claim 25, claim 30 is allowable over the cited prior art references, and applicants respectfully request withdrawal of the rejection with respect to claim 30 under 35 U.S.C. § 103(a) over the combination of Nishimura, Kaku and Sakai.

XI.) Response to Rejection of claim 31 under § 103(a)

Claim 31 was rejected under 35 U.S.C. § 103(a) as obvious over Nishimura, Kaku and Takeuchi. Applicants respectfully assert, however, that as claim 31 depends from independent claim 25, it includes all the limitations recited therein. Takeuchi fails to overcome the deficiencies cited above with regards to Nishimura and Kaku, in the context of the patentability of independent claim 25. Consequently, Nishimura and Kaku, alone or in any proper combination with Takeuchi, fail to disclose or suggest applicants' invention as recited in independent claim 25, and the feature of claim 31. Specifically, the cited prior art references fail to disclose or suggest wherein the remaining storage capacity of the recording medium, which is available for storage of information, is detected to be indicated.

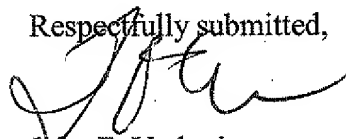
Therefore, and for at least the reasons provided above for the patentability of independent claim 25, claim 31 is allowable over the cited prior art references, and applicants respectfully request withdrawal of the rejection with respect to claim 31 under 35 U.S.C. § 103(a) over the combination of Nishimura, Kaku and Takeuchi.

## CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 1, 4 – 6, 9 and 14 – 16, 19 – 21, 23 and 25 – 34 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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